

REMARKS

This Response is submitted in reply to the Office Action dated September 28, 2004. Claims 1, 18, 32, 44, 57, 58 and 65 have been amended. No new matter has been added through these amendments.

A Terminal Disclaimer and a Petition for a One Month Extension of Time to File the Response are submitted herewith. A check in the amount of \$250.00 is submitted herewith to cover the cost of the Terminal Disclaimer and the one-month extension. Please charge Deposit Account No. 02-1818 for any insufficiency of payment or credit for any overpayment.

On page two of the copy of the PTO-1449 form considered on September 23, 2004, the Examiner has not indicated that he has considered each of the references cited. Applicants respectfully request that such documents be considered in connection with this Response.

The Office Action rejected Claims 1 to 46 and 48 to 73 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 to 11 of U.S. Patent No. 6,659,864 B2 in view of Menke. As indicated in the Office Action, Applicants are hereby submitting a Terminal Disclaimer to overcome these rejections over U.S. Patent No. 6,659,864 B2 in view of Menke. Accordingly, Applicants respectfully submit that these rejections are overcome.

The Office Action rejected Claims 47 and 48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 to 11 of U.S. Patent No. 6,659,864 B2 in view of Menke in further view of Minoru. As indicated in the Office Action, Applicants are hereby submitting a Terminal Disclaimer to overcome these rejections over U.S. Patent No. 6,659,864 B2 in view of Menke and in further view of Minoru. Accordingly, Applicants respectfully submit that these rejections are overcome.

The Office Action rejected Claims 1 to 9, 17 to 24, 32 to 35, 43, 57 to 61 and 72 to 74 under 35 U.S.C. §102(b) as being anticipated by Menke. As discussed during the interview, Applicants respectfully disagree with these rejections because Menke does not teach each and every aspect of the claimed invention.

Menke relates to a coin-operated gaming device having revolving flip-card carousels which are arranged in two rows one above the other. Each flip card bears part of a game deciding symbol only on one side, wherein two cards form a complete playing card. In operation, two players compete in a card game, wherein each player is assigned one of the rows of flip-card carousels. In the card game, each player draws one of more cards and each drawn card causes one of that player's assigned flip-card carousels to display a complete playing card. The card game outcome is based on each player's displayed playing cards.

Amended independent Claim 1 is directed to a gaming device including, amongst other elements, a cabinet, a primary game operable upon a wager by a player, a secondary game associated with the primary game, a primary display supported by the cabinet, the primary display adapted to display the primary game and a secondary display supported by the cabinet, the secondary display adapted to display the secondary game.

As discussed during the telephone interview, Menke does not disclose a secondary game associated with a primary game or a secondary display adapted to display the secondary game. In Menke, the two rows of revolving flip-card carousels function in the primary card game. On the other hand, unlike Menke, the gaming device of amended independent Claim 1 includes a secondary game associated with a primary game and a secondary display adapted to display the secondary game. For these reasons, Applicants respectfully submit that amended independent Claim 1 is patentably distinguished over Menke and in condition for allowance.

Claims 2 to 9 and 17 depend directly or indirectly from independent Claim 1 and are also allowable for the reasons given with respect to independent Claim 1 and because of the additional features recited in these claims.

Amended independent Claims 18, 32, 57 and 58 and independent Claim 72 are each directed to a gaming device/method of operating a gaming device including, in combination with other elements, a primary game operable upon a wager, a secondary game associated with the primary game, a primary display adapted to display the primary game and a secondary display adapted to display the secondary game. As described above with respect to amended independent Claim 1, the two rows of

revolving flip-card carousels in Menke are utilized by the two players in the primary card game. That is, Menke does not disclose a secondary game associated with a primary game or a secondary display adapted to display the secondary game. On the other hand, the gaming device/method of operating a gaming device of Claims 18, 32, 57, 58 and 72 each disclose a secondary game associated with a primary game and a secondary display adapted to display the secondary game. For these reasons, Applicants respectfully submit that independent Claims 18, 32, 57, 58 and 72 are patentably distinguished over Menke and in condition for allowance.

Claims 19 to 24, 33 to 35, 43, 59 to 61, 73 and 74 depend directly or indirectly from Claims 18, 32, 57, 58 and 72, respectively and are also allowable for the reasons given with respect to Claims 18, 32, 57, 58 and 72 and because of the additional features recited in these claims.

The Office Action rejected Claims 11 to 16, 26 to 31, 37 to 42, 44 to 46, 49 to 56 and 62 to 71 under 35 U.S.C. §103(a) as being unpatentable over Menke in view of Groetchen. Applicants respectfully disagree because the gaming device resulting from the combination of Menke and Groetchen does not teach, disclose or suggest a secondary game associated with a primary game or a secondary display adapted to display the secondary game.

As described above, Menke relates to a two-player card game wherein revolving flip-card carousels are utilized to display cards to the players. The Office Action states that Groetchen discloses slidable shutters which mask award indicia on mechanical reels. Accordingly, the gaming device resulting from the combination of Menke and Groetchen would include a plurality of slidable shutters to mask the cards displayed by the revolving flip-card carousels.

Claims 11 to 16, 26 to 31, 37 to 42, 44 to 46, 49 to 56 and 62 to 71 each disclose a gaming device/method of operating a gaming device including, in combination with other elements, a primary game operable upon a wager, a secondary game associated with the primary game, a primary display adapted to display the primary game, a secondary display adapted to display the secondary game.

The Office Action states that it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Menke, wherein flip cards

conceal award indicia, to substitute the mechanical reels concealed by shutters as described in Groetchen. Applicants respectfully submit that regardless of if it would have been obvious to add the shutters of Groetchen to the flip cards of Menke, the gaming device resulting from the combination of Menke and Groetchen would not disclose, teach or suggest a secondary game associated with a primary game or a secondary display adapted to display the secondary game. On the other hand, each gaming device/method of operating a gaming device of each of Claims 11 to 16, 26 to 31, 37 to 42, 44 to 46, 49 to 56 and 62 to 71 includes a secondary game associated with a primary game and a secondary display adapted to display the secondary game. For this reason, Applicants respectfully submit that Claims 11 to 16, 26 to 31, 37 to 42, 44 to 46, 49 to 56 and 62 to 71 are patentably distinguished over Menke and Groetchen and in condition for allowance.

The Office Action rejected Claims 10, 25 and 36 under 35 U.S.C. §103(a) as being unpatentable over Menke in view of Groetchen, in further view of Krise. Applicants respectfully disagree and submit that the gaming device resulting from the combination of Menke, Groetchen and Krise would not teach, disclose or suggest a secondary game associated with a primary game or a secondary display adapted to display the secondary game.

As described above, Menke relates to a two-player card game wherein revolving flip-card carousels are utilized to display cards to the players and Groetchen discloses slidable shutters to mask award indicia included on mechanical reels. As stated in the Office Action, Krise discloses that gaming machines have replaced spinning mechanical reels with video displays.

Claims 10, 25 and 36 each disclose a gaming device including, in combination with other elements, a primary game operable upon a wager, a secondary game associated with the primary game, a primary display adapted to display the primary game, a secondary display adapted to display the secondary game.

The Office Action states that it would have been obvious to a gaming artisan at the time of the invention to modify the gaming device suggested by Menke in view of Groetchen by replacing the mechanical displays with video displays in order to reduce the maintenance cost of the device. Applicants respectfully submit that regardless of if

it would have been obvious to combine the flip cards of Menke with the shutters and mechanical reels of Groetchen, with the video displays of Krise, the gaming device resulting from the combination of Menke, Groetchen and Krise would not disclose, teach or suggest a secondary game associated with a primary game or a secondary display adapted to display the secondary game. On the other hand, the gaming devices of each of Claims 10, 25 and 36 includes a secondary game associated with a primary game and a secondary display adapted to display the secondary game. For this reason, Applicants respectfully submit that Claims 10, 25 and 36 are patentably distinguished over Menke, Groetchen and Krise and in condition for allowance.

The Office Action rejected Claims 47 and 48 under 35 U.S.C. §103(a) as being unpatentable over Menke in view of Groetchen, in further view of Minoru. Applicants respectfully disagree and submit that the gaming device resulting from the combination of Menke, Groetchen and Minoru would not teach, disclose or suggest a second display juxtaposed next to a first display, the second display adapted to display the secondary game.

As described above, Menke relates to a two-player card game wherein revolving flip-card carousels are utilized to display cards to the players and Groetchen discloses slidable shutters to mask award indicia included on mechanical reels. The Office Action states that Minoru discloses a gaming device with a sensing device.

Claims 47 and 48 each disclose a gaming device including, in combination with other elements, a primary game operable upon a wager, a secondary game associated with the primary game, a first display adapted to display the primary game and a second display juxtaposed next to the first display, the second display adapted to display the secondary game.

The Office Action states that it would have been obvious to a gaming artisan at the time of the invention to modify the gaming device suggested by Menke in view of Groetchen to add the feature of a first sensing device and a second sensing device. Applicants respectfully submit that regardless of if it would have been obvious to combine the flip cards of Menke with the shutters and mechanical reels of Groetchen, with the sensing devices of Minoru, the gaming device resulting from the combination of Menke, Groetchen and Minoru would not disclose, teach or suggest a second display

juxtaposed next to a first display, the second display adapted to display the secondary game. On the other hand, the gaming devices of each of Claims 47 and 48 includes a second display juxtaposed next to a first display, the second display adapted to display the secondary game. For this reason, Applicants respectfully submit that Claims 47 and 48 are patentably distinguished over Menke, Groetchen and Minoru and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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